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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,724	01/07/2004	Stefano Oggioni	FR920010058US1	1723

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INTERNATIONAL BUSINESS MACHINES CORPORATION  
DEPT. 18G  
BLDG. 300-482  
2070 ROUTE 52  
HOPEWELL JUNCTION, NY 12533

EXAMINER
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EDMONDSON, LYNNE RENEE

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/707,724

Applicant(s)

OGGIONI, STEFANO

Examiner

Lynne Edmondson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 8-12 is/are rejected.
- 7) ☒ Claim(s) 2,3,6,7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

IL

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5 and 8 are rejected under 35 U.S.C. 102(a) as being anticipated by Hayashi et al. (USPN 6472079 B2).

Hayashi teaches a paste for protecting circuits comprising a salt, potassium citrate (col 10 lines 1-10), glycerol (col 14 lines 27-47) and a colloid (col 15 line 44 – col 16 line 32).

3. Claims 1, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Degani et al. (USPN 6043670)

Degani teaches a paste for protecting which include mounted chips (col 2 lines 25-53 and col 4 lines 13-35) comprising a salt, glycerol and a densifier, gum (col 3 line 47 – col 4 line 8). The paste is printed (col 4 lines 13-15).

4. Claims 1 and 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Drzaic et al. (USPN 6842657 B1).

Drzaic teaches a paste for protecting circuits (col 2 lines 50-56) comprising a salt (col 15 lines 1-33), glycerol and a colloidal densifier, acacia (col 15 lines 34-41 and col 15 line 57 – col 16 line 8). The paste is printed (col 8 lines 14-38).

5. Claims 1, 4, 5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Caton (US 2004/0234701 A1).

Caton teaches a paste for protecting circuits (paragraph 9) comprising a salt, sodium or potassium citrate (paragraph 68), glycerol (paragraph 50) and a colloid (paragraph 58).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Degani et al. (USPN 6043670).

Degani teaches a paste for protecting which include mounted chips (col 2 lines 25-53 and col 4 lines 13-35) comprising a salt, glycerol and a densifier, gum (col 3 line

47 – col 4 line 8). The paste is printed (col 4 lines 13-15). However there is no disclosure of a wire bond.

It would have been obvious to one of ordinary skill in the art at the time of the invention that bump and ball bonds (col 2 lines 35-45) are obvious variations of wire bonds and that the presence or lack of a wire bond (which is not covered by the protective paste) does not further limit the paste composition. Wire bonding of chips is well known and conventional in the art.

#### ***Allowable Subject Matter***

8. Claims 2, 3, 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Saba (USPN 3448512, colloid, printing), Rolker et al. (USPN 3900320), Poliak et al. (USPN 3730782) and Brown (USPN 2798053).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Edmondson whose telephone number is (571)

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272-1172. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lynne Edmondson  
Primary Examiner  
Art Unit 1725

LRE

LYNNE R. EDMONDSON  
PRIMARY EXAMINER

4/6  
2/24/05